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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/593,828	06/13/2000	Steven Rosen	6510-138US1	7507

7590 01/13/2004

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EXAMINER

MONSHIPOURI, MARYAM

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 01/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/593,828

Applicant(s)

ROSEN ET AL.

Examiner

Maryam Monshipouri

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-57 and 59-77 is/are pending in the application.
- 4a) Of the above claim(s) 1-4 and 13-57 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5, 7, 9-12 and 59-77 is/are allowed.
- 6) ☒ Claim(s) 8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) Filed 2/13/03
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Applicant's response filed 10/22/2003 is acknowledged. Claims 1-5, 7-57, 59-77 are pending. Claims 5, 7-12, and 59-70 and newly added claims 71-77 are still at issue and under consideration. Claims 1-4, 13-57 are withdrawn as drawn to non-elected invention.

Rejections and/or objections not reiterated from previous office actions are hereby withdrawn.

It is noted that applicant requested rejoinder of method claims. The only method claim that depends from elected subject matter (claim 12) has already been examined and allowed (see below).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 8, as amended, is directed to a **genus** of DNA sequences that need to hybridize to SEQ ID NO:4 or complement thereof at very low stringent hybridization conditions and therefore have not been adequately described in terms of structure in the specification.

The specification does not contain any disclosure of the structure of all DNA sequences that hybridize to SEQ ID NO:4 or complement thereof, under conditions recited in claim 8, that can retain glycosyltransferase activity. The genus of cDNAs that comprise these above cDNA molecules is a large variable genus with a lot of structural diversity, comprising numerous species that totally lack capability of encoding a glycosyl transferase. Therefore, some guidance about the structural requirements of cDNA sequences that have potential of retaining a structure encoding a product with glycosyltransferase activity is required that is currently lacking in the specification. The specification discloses only **a single species** of the claimed genus (namely SEQ ID NO:4) which is insufficient to put one of skill in the art in possession of the attributes and features of all species within the claimed genus. Therefore, one skilled in the art cannot reasonably conclude that the applicant had possession of the claimed invention at the time the instant application was filed.

Applicant is referred to the revised interim guidelines concerning compliance with the written description requirement of U.S.C. 112, first paragraph, published in the Official Gazette and also available at www.uspto.gov.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 8 is rejected under 35 U.S.C. 102(e) as being anticipated by Habuchi et al. (U.S. Patent No. 5,910,581, issued 6/8/99). Habuchi teaches a DNA sequence that displays 54% local similarity to SEQ ID NO:4 of this invention (see the attached sequence alignment) and is encoding a glycosyl sulfotransferase. Said sequence is capable of hybridizing to SEQ ID NO:4 or complement thereof at 50 °C in claimed salt conditions, anticipating claim 8.

Claim 8 is rejected under 35 U.S.C. 102(e) as being anticipated by Bistrup et al. (U.S. Patent No. 6265192, cited previously). Bistrup teaches a DNA sequence that displays 63.6% local similarity to SEQ ID NO:4 of this invention, wherein its sequence encodes a glycosyl transferase. Said sequence is capable of hybridizing to SEQ ID NO:4 or complement thereof at 50 °C in claimed salt conditions, anticipating claim 8.

Allowable Subject Matter

Claims 5, 7, 9-12, 59-77 are allowed. This is because SEQ ID NO:3-4 and 8 are free of prior art. Further, the compositions of said sequences are not suggested in the prior art. Hence, said sequences are also non-obvious. Since said sequences are both novel and non-obvious, their specifically claimed homologs and fragments as well as host cells and vectors comprising all said products together with methods of expressing said products are also novel and non-obvious.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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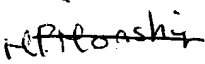
§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maryam Monshipouri whose telephone number is (703)308-1235. The examiner can normally be reached on 7:00 a.m to 5:30 p.m. except for Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnanthapu Achutamurthy can be reached on (703)308-3804. The fax phone number for the organization where this application or proceeding is assigned is (703)308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-0196.


MARYAM MONSHIPOURI, PH.D.
PRIMARY EXAMINER
